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ANTONIENKO, DEBRA L				
ART UNIT		PAPER NUMBER		
3689				
NOTIFICATION DATE		DELIVERY MODE		
06/25/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOmail2@bakerbotts.com  
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### Office Action Summary

**Application No.**

10/606,661

**Applicant(s)**

KANANGHINIS ET AL.

**Examiner**

DEBRA ANTONIENKO

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 June 2003.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-18 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 06/25/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 10/10/2003  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. Figures 1, 6-12 are not of sufficient quality to permit examination. They are too dark to read the print. Accordingly, replacement drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to this Office action. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claim 1 of Myrick et al., U.S. Patent Number 7,162,427 B1 (hereinafter referred to as Myrick) in view of Baudoin et al., U.S. Patent Number 7,290,275 B2 (hereinafter referred to as Baudoin). Although the conflicting claims are not identical, they are not patentably distinct from each other because Claim 1 of the current application substantially recites the limitations of Claim 1 of Myrick and merely adds an obvious feature as compared in Table 1 below. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the security measures of Baudoin into Myrick's business modeling in order to protect the information and practices of an enterprise.

Table 1

Myrick	Application 10/606661
<p>1. A method of <b>computer</b> modeling integrated business and information technology frameworks and architecture in support of a business comprising:</p> <p>identifying <b>in a computer</b> manageable entities of the business and the <b>existing</b> information technology supported <b>by each manageable entity</b>;</p> <p>generating <b>by the computer</b> an overall architecture for the business, the overall architecture defining how the manageable entities relate to each other <b>and to the existing information technology</b>;</p> <p>implementing <b>in the computer</b> a common language in order to articulate the overall architecture;</p> <p>generating <b>by the computer</b> a graphical representation of the overall architecture for the business according to the common language;</p> <p>determining <b>by the computer</b> information technology requirements for the business <b>in response to the existing information technology and the relationship among the manageable entities</b>; and</p> <p>generating <b>by the computer</b> a plan for implementation and deployment of <b>future</b> information technology</p>	<p>1. A method of modeling integrated business and information technology frameworks and architecture in support of a business comprising:</p> <p>identifying manageable entities of the business and the supporting information technology;</p> <p>generating an overall architecture for the business, the overall architecture defining how the manageable entities relate to each other;</p> <p>implementing a common language in order to articulate the overall architecture; and</p> <p>generating a graphical representation of the overall architecture for the business according to the common language;</p> <p>analyzing information technology requirements for the business; and</p> <p>generating a plan for implementation and deployment of information technology within</p>

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<p><b>among the manageable entities based on the determined information technology requirements for display by the computer</b> within the graphical representation of the overall architecture;</p> <p>wherein the overall architecture contains a plurality of components, the plurality of components including a strategic plan, a business architecture, an information architecture, an application architecture, a technology infrastructure architecture, and an enterprise IT management framework.</p>	<p>the graphical representation of the overall architecture;</p> <p>wherein the overall architecture contains a plurality of components, the plurality of components including a strategic plan, a business architecture, an information architecture, an application architecture, a technology infrastructure architecture, <b>a security architecture</b>, and an enterprise IT management framework.</p>
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### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

6. A method claim does not qualify as a statutory process if purely mental steps are listed. Thus, to qualify as a § 101 statutory process, the claim should positively

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recite the other statutory class (the thing or product) to which it is tied. For example, identifying the apparatus that accomplishes the method steps, or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

7. In the current application, the method steps fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Thus, Claim 1 is non-statutory since the steps may be performed within the human mind. Claims 2-11 are dependent on Claim 1 and therefore are rejected in a like manner.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buteau et al., U.S. Patent Number 6,442,557 B1 (hereinafter referred to as Buteau) in view of Baudoin et al., U.S. Patent Number 7,290,275 B2 (hereinafter referred to as Baudoin).

**Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire

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reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Regarding Claim 1:

Buteau discloses a method of modeling integrated business and information technology frameworks and architecture in support of a business comprising:

identifying manageable entities of the business and the supporting information technology (column 1, lines 58-67; column 2, lines 53-63);

generating an overall architecture for the business, the overall architecture defining how the manageable entities relate to each other (column 5, lines 43-51);

implementing a common language in order to articulate the overall architecture (column 7, lines 19-34); and

generating a graphical representation of the overall architecture for the business according to the common language (column 7, lines 19-34; Figure 7);

analyzing information technology requirements for the business (column 1, lines 58-67); and

generating a plan for implementation and deployment of information technology within the graphical representation of the overall architecture (column 5, lines 21-42; column 6, lines 6-39);

wherein the overall architecture contains a plurality of components, the plurality of components including a strategic plan (see Claim 3), a business architecture (see Claim 4), an information architecture (see Claim 5), an application architecture (see Claim 6), a technology infrastructure architecture (see Claim 7),..., and an enterprise IT management framework (see Claim 9).

Buteau does not explicitly disclose a security architecture.

However, Baudoin does disclose a security architecture (Abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the security architecture of Baudoin into Buteau's enterprise architecture in order to protect the information and practices of an enterprise.

Regarding Claim 2:

Buteau and Baudoin teach the limitations of Claim 1 as described above.

Buteau further teaches wherein the overall architecture addresses people, processes, and technology of the business (column 1, lines 30-35).

Regarding Claim 3:

Buteau and Baudoin teach the limitations of Claim 1 as described above.

Buteau further teaches wherein the strategic plan component includes a business plan, a product plan, a financial plan, an organization plan, a marketing plan, and an information technology plan in support of the aforementioned plans (column 1, lines 58-67; column 11, line 59 – column 12, line 32; column 20, lines 62-66).

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Regarding Claim 4:

Buteau and Baudoin teach the limitations of Claim 1 as described above.

Buteau further teaches wherein the business architecture component defines current business direction, objectives, and supporting processes as well as future direction, objectives, and supporting processes (column 2, lines 14-17).

Regarding Claim 5:

Buteau and Baudoin teach the limitations of Claim 1 as described above.

Buteau further teaches wherein the information architecture component provides information and data management precepts, an information-application software portfolio, and a geo-structural view of information specific technology deployment (column 15, line 24 – column 17, line 37).

Regarding Claim 6:

Buteau and Baudoin teach the limitations of Claim 1 as described above.

Buteau further teaches wherein the application architecture component defines an application software portfolio and integration relationships for the business (column 21, line 49 – column 22, line 14).

Regarding Claim 7:

Buteau and Baudoin teach the limitations of Claim 1 as described above.

Buteau further teaches wherein the technology infrastructure architecture component enables access to information and, geo-structural layouts for IT platforms (column 17, line 38 – column 22, line 62).

Regarding Claim 8:

Buteau and Baudoin teach the limitations of Claim 1 as described above.

Baudoin further teaches wherein the security architecture component describes how security measures fit into the overall architecture of the business to meet its security objectives (Abstract; Figure 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the security architecture of Baudoin into Buteau's enterprise architecture in order to protect the information and practices of an enterprise.

Regarding Claim 9:

Buteau and Baudoin teach the limitations of Claim 1 as described above.

Buteau further teaches wherein the enterprise information technology management framework component provides information technology services and products, management of the services, IT systems and network management, and the enterprise IT management organization capabilities, competencies, skills, and performance models (column 6, lines 29-47).

Regarding Claim 10:

Buteau and Baudoin teach the limitations of Claim 1 as described above.



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Buteau further teaches further comprising: decomposing the manageable entities so that each manageable entity has a relative independence from other manageable entities but is in context with the overall enterprise architecture (column 5, lines 52-62).

Regarding Claim 11:

Buteau and Baudoin teach the limitations of Claim 1 as described above.

Buteau further teaches wherein the overall architecture provides the starting point for determining the context and foundation components and elements needed to build either a Strategic IT Plan, overall enterprise architecture, or enabling IT solutions for an enterprise (column 1, lines 16-22).

Regarding Claim 12:

Buteau teaches a computer readable medium (column 4, lines 48-63) including code for modeling integrated business and information technology frameworks and architecture in support of a business, the code operable to:

generate an overall architecture defining how manageable entities of a business relate to one another (see Claim 1), the overall architecture including:

a strategic business plan component providing context and guidance that drive definition of business functions, processes, systems, and organization (see Claim 3);

a business architecture component reflecting what the business does in the present as well as in the future to accomplish particular business requirements (see Claim 4);

an information architecture component representing what information is to be delivered to individuals across the business (see Claim 5);

an application architecture component supporting business process execution and information flow (see Claim 6);

a technology infrastructure architecture supporting execution of activities and defining what information technology components are needed to enable access to information (see Claim 7);

a security architecture component describing how security measures fit into the overall architecture of the business to meet its security objectives (see Claim 8);

an enterprise information technology management architecture component dealing with business and organizational management of providing information technology services and products as well as systems, network, and element management (see Claim 9).

Regarding Claim 13:

Buteau and Baudoin teach the limitations of Claim 12 as described above.

Baudoin further teaches wherein the security architecture component includes security and business continuity requirements (column 12, *Implications for business continuity plans...*; column 25, *Business Continuity Arrangements...*),

an information security view (column 28, *Security of exchange of data...*; column 36, *Validation control while data input...*),

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an application security view (column 29, *Business Requirements for Access Control...application access*),

a security infrastructure view (column 9, *Information Security Infrastructure...*), and

an information security administration/management/training view (column 10, *Information security education and training*; column 16, *User Training...*; column 26, *Procedures for reporting and recovery...*; column 30, *User Access Management...*).

Regarding Claim 14:

Buteau and Baudoin teach the limitations of Claim 13 as described above.

Baudoin further teaches wherein the information security view is responsible for supervision of data within the overall architecture of the business (column 28, *Security of exchange of data...*; column 36, *Validation control while data input...*).

Regarding Claim 15:

Buteau and Baudoin teach the limitations of Claim 13 as described above.

Baudoin further teaches wherein the application security view is responsible for the supervision of applications within the overall structure of the business (column 29, *Business Requirements for Access Control...application access*).

Regarding Claim 16:

Buteau and Baudoin teach the limitations of Claim 13 as described above.

Baudoin further teaches wherein the security infrastructure view is responsible for supervision of the infrastructure within the overall architecture of the business (column 9, *Information Security Infrastructure...*).

Regarding Claim 17:

Buteau and Baudoin teach the limitations of Claim 13 as described above.

Baudoin further teaches wherein the information security administration/management/training view is responsible for managing access and within the overall structure of the business (column 10, *Information security education and training*; column 16, *User Training...*; column 26, *Procedures for reporting and recovery...*; column 30, *User Access Management...*).

Regarding Claim 18:

Buteau and Baudoin teach the limitations of Claim 13 as described above.

Baudoin further teaches wherein the security and business continuity requirements provide inputs for implementing information security within the overall architecture of the business (column 12, *Implications for business continuity plans...*; column 25, *Business Continuity Arrangements...*).

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### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBRA ANTONIENKO whose telephone number is (571)270-3601. The examiner can normally be reached on Monday through Thursday, 7:30 AM to 4:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner, Art Unit 3689  
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